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**C. REMARKS**

Claims 1-20 are currently present in the Application and stand rejected. Claims 1, 8, and 14 are independent claims. No claims have been amended, added, or cancelled in this Response.

The Current Office Action is the third Office Action received by Applicants. To date, Applicants have not amended or cancelled a single claim from the originally filed claims. Applicants successfully traversed the rejections set forth in the First Office Action (mailing date 04/30/2004) rejecting Applicants' claims under 35 U.S.C. § 102 as being anticipated by Sarno (U.S. Publ. 2002/0042751) and under 35 U.S.C. § 103 as being obvious, and therefore unpatentable over Sarno in view of Bowman-Amuah (U.S. Pat. No. 6,662,357). The Second Office Action (mailing date 01/04/2005) was a Final Office Action and maintained the same rejections. In response, Applicants appealed the final rejection and filed an Appeal Brief (06/02/2005) requesting that the Board reverse the rejections as (1) Sarno was not prior art to Applicants' invention, and (2) the art of record simply did not teach or suggest Applicants' claimed invention. In response to Applicants' Appeal Brief, the Examiner issued another non-final Office Action (mailing date 07/28/2005). As explained in detail below, each of Applicants' claims is allowable over the newly cited art. Accordingly, in light of the delays in prosecuting the instant Application, coupled with the fact that the newly cited art does not teach or suggest Applicants' claimed invention, Applicants respectfully request an expedited allowance of Applicants' claims.

**1. Examiner Interview**

Applicants note with appreciation the Examiner Interview that Applicants' representative had with the Examiner on October 25, 2005. The art of record was discussed in light of Applicants' claims, with focus applied to claims 1 and 7. While no agreement was reached, the Examiner said that he would closely review Applicants' Response before the next Office Communication. The Examiner's attention to Applicants' remarks in this Response is appreciated.

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**2. Superfluous Requirements Set Forth in the Current Office Action**

Applicants assume that the Examiner has withdrawn the rejections that relied upon Sarno and Bowman-Amuah as these references are no longer cited in the rejections that appear in the present Office Action. However, on page 2 of the present Office Action, the Examiner references Applicants' Declaration filed under 37 C.F.R. § 1.131 (swearing behind the Sarno reference). The Examiner notes that the "exact date of the exhibits" used in the 1.131 declaration cannot be determined. The Examiner then states that "applicant (sic) is hereby required to provide all required information including specifically pointing out or mapping each claim limitation [claims 1-20] into his/her submitted Exhibit "A", and Exhibit "B" in response to this Office Action." (emphasis in original). Applicants respectfully point out that the Examiner provides no support whatsoever from the MPEP that require either (1) the stating of exact dates in a § 1.131 declaration, or (2) the mapping of every claim element to exhibits included in a declaration filed under 37 C.F.R. § 1.131. A review of relevant sections of the MPEP reveals that there is no support whatsoever for the Examiner's requests. Moreover, because the Examiner is no longer relying on the Sarno reference in rejecting Applicants' claimed invention, there is no basis for requesting such information. Accordingly, Applicants respectfully request that the Examiner withdraw the improper requests set forth on page 2 of the current Office Action as neither is required by the MPEP and, even if required, neither is necessitated by the rejections set forth in the current Office Action.

**3. Double Patenting Rejection**

The Office Action provisionally rejected claims 1-20 under the judicially created doctrine of obviousness-type double patenting, as being unpatentable over claims 1-20 of co-pending application number 09/996,131. Applicants note the provisional nature of this rejection. Accordingly, upon allowance of any of the claims of the co-pending application, Applicants hereby agree to file, through their appointed representative, a proper terminal disclaimer pursuant to 37 C.F.R. 1.321.

**4. Prior Art Rejections**

The Office Action rejects claims 1-6, 8-12, and 14-19 under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent 6,377,934 to Chen et al. (hereinafter "Chen"). The Office Action also

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rejects claims 7, 13, and 20 under 35 U.S.C. § 103(a) as being obvious, and therefore unpatentable, over Chen in view of U.S. Patent No. 6,772,216 to Ankireddipally et al. (hereinafter Ankireddipally). The rejections are respectfully traversed.

**A. Alleged Anticipation Under 35 U.S.C. § 102(e) (the Chen patent)**

In order to anticipate under 35 U.S.C. § 102, the Chen reference must teach each and every element as set forth in Applicants' claims. MPEP § 2131, citing *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). As discussed below, it is readily apparent that Chen falls well short of this requirement.

In each of the independent claims (1, 8, and 14), Applicants claim a method / system / program product of calibrating a topography for a client with limitations of:

- identifying one or more client attributes corresponding to the client;
- comparing the identified client attributes to one or more topographical components;
- selecting one or more of the topographical components based on the comparing; and
- installing the selected topographical components on one or more client computer systems.

The present Office Action contends that Chen teaches each of these limitations. Chen is a patent directed to "organizing information from systems in a data warehousing environment" (see Abstract), while Applicants' invention is directed to calibrating a topography for a client. Applicants describe "topography" as a fabric, or framework, that provides an infrastructure that supports the customer's management philosophy and other requirements (see page 5, lines 5-8). Applicants further describe "topography components" as those components designed and created to address the customer's topography design with "calibration factors" that determine how the topography components are designed and built to support the management philosophies and methodologies (see page 5, line 9 to page 6 line 5).

The present Office Action cites Chen as teaching each of the limitations set forth in

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Applicants' independent claims. The Office Action cites col. 8, lines 30-38 and 49-55, and Figs. 3B and 4A as teaching Applicants' "identifying..." limitation.

Chen, col. 8, lines 30-38:

The data model of FIG. 4A is a data model having a reverse star schema organization. FIG. 4A illustrates a representative data model comprising a focal group 210, comprising at least one of a plurality of core components 212, at least one of a plurality of customer classification components 213, at least one of a plurality of customized groups 211, at least one of a plurality of customer activity components 215 and at least one of a plurality of activity lookup components 214.

Chen, col. 8, lines 49-55:

FIG. 4A. illustrates core components 212, and customer classification components 213. Core components 212 include a Customer entity (CC1) and other related customer identity data designated by (CC2-CCn). Information such as an account identifier, social security number, encrypted name, and the like are examples of such customer identity data.

Applicants note that the customer attributes noted by Chen are directed towards Chen's system of analyzing data sources (databases). Therefore, the customer data discussed by Chen relates to "customer identity data" such as "account identifiers" and the like. Importantly, none of the client attributes taught by Chen relate to topographical components, as taught and claimed by Applicants. In Applicants' next limitation, the client attributes are compared to "topographical components." As Chen does not teach or describe client attributes that relate to topographical components, it follows that Chen cannot teach or suggest a comparison of such attributes to topographical components. The Office Action cites col. 11, lines 9-12, lines 25-27, and lines 39-45, and Figs. 5A-5B as teaching Applicants' "comparing..." limitation.

Chen, col. 11, lines 9-12:

Entities to be included in core components 212 and customer classification components 213 can be selected based upon fit to users' needs based on their business processes and operations.

Chen, col. 11, lines 25-27:

Activity lookup components 214 can comprise, for example, business entities referenced in business transactions, such as products, stores, and the like.

Chen, col. 11, lines 39-45:

In a step 412, a plurality of source data tables and attributes are selected to match selected entities, such as the entities selected in 407. In some embodiments, users can browse and navigate through a data model of a data source, such as source data 101, to select data tables and attributes to comprise the source of the data tables and attributes of the customer-centric data warehouse.

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In Figures 5A and 5B as well as the cited sections above, Chen is describing how a database data model is generated by converting a template schema into a physical schema in order to create a customer-centric data warehouse. Importantly, as will be seen in the discussion of the remaining limitations of the independent claims, Chen does not teach or suggest “selecting... topographical components...” nor does Chen teach or suggest “installing” such topographical components.

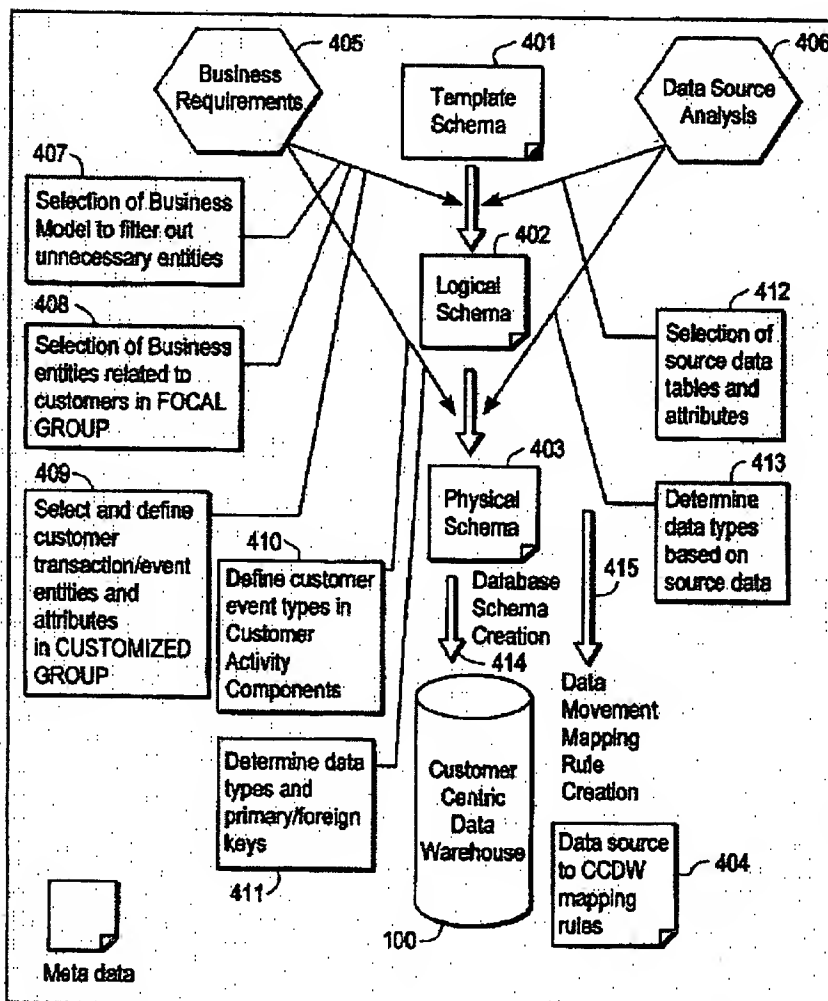


FIG. 5A

Note in Figure 5A, Chen's result is a “customer centric data warehouse.” Chen does not teach or suggest any resulting “topographical components.” In other words, Chen's result is a

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database design (schema) and Chen does not teach or suggest any “topographical components” as taught and claimed by Applicants.

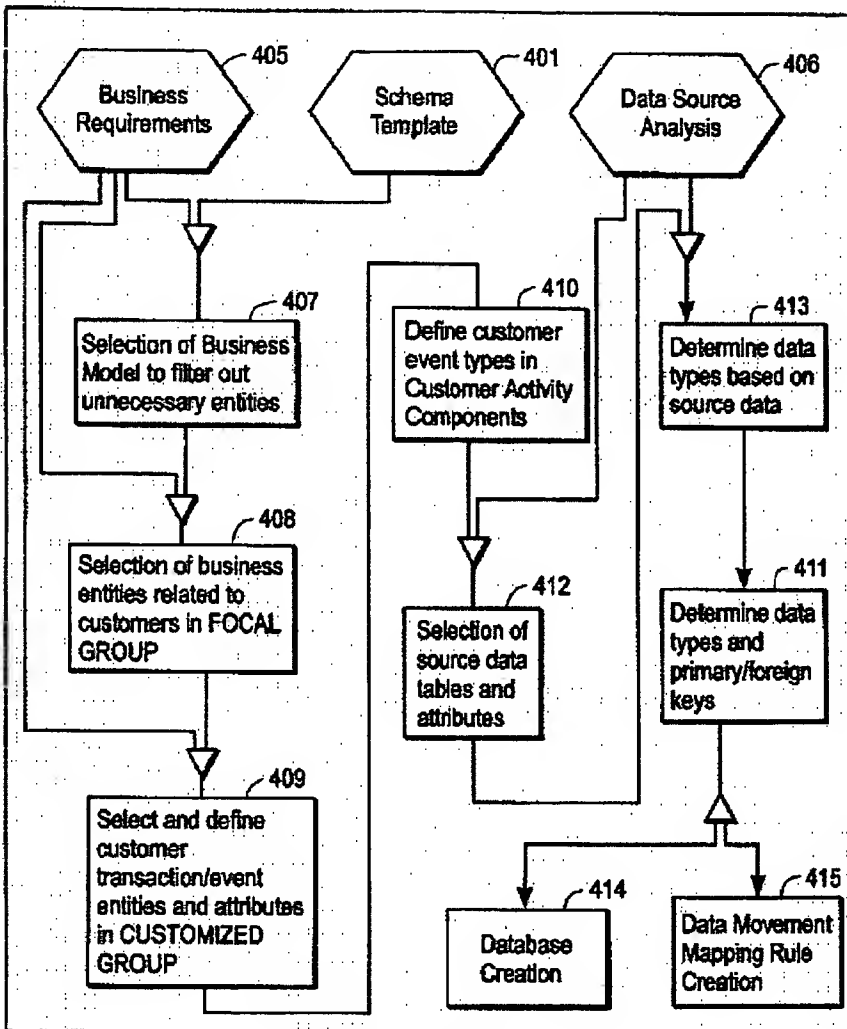


FIG. 5B

Similarly to Figure 5A, in Figure 5B, Chen’s system results in a created database (414) as well as “data movement mapping rules” (415). Chen’s data movement mapping rules provide information about translation of information in tables and attributes of data sources (see col. 12, lines 5-16). Once again, however, Chen does not teach or suggest any resulting “topographical components” as taught and claimed by Applicants.

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Applicants' next limitation is "selecting one or more of the topographical components based on the comparing." The Office Action cites col. 10, line 63 to col. 11, line 12 as teaching this limitation. These sections of Chen read as follows:

Chen, col. 10, line 63 to col. 11, line 12:

Selection of a business model can eliminate unnecessary entities from further consideration. In this step, a pre-defined business model is selected from a plurality of such pre-defined business models. Different applications can use different business models having entities relevant to their business processes and operations. In a presently preferable embodiment, users can select from a plurality of pre-built entities in a template for a particular data schema 401 based upon business requirements 405 relevant to the business of the user. Then, in a step 408, customer entities are selected from a plurality of pre-defined customer entities in a focal group, such as focal group 210 of FIG. 4A. This eliminates more non-relevant entities from further consideration. Entities to be included in core components 212 and customer classification components 213 can be selected based upon fit to users' needs based on their business processes and operations.

Throughout Chen, and in particular the cited sections and Figures that appear above, focus on selection of a "business model" in order to eliminate "unnecessary" database entities from consideration. The Office Action seems to confuse Chen's "business models" with Applicants' topographical components. In addition, Chen never teaches or suggests selecting or installing software components onto a client computer system. Instead, Chen is simply comparing a customer's business model (business processes and operations) with a set of pre-defined models in order to help decide what database entities should be included in the database that Chen creates for the customer. As is well known, the database models taught by Chen are not interchangeable, nor are they similar, to software components, such as the topographical components taught and claimed by Applicants.

The Office Action cites col. 12, lines 40-53 and Figs. 6A-6B as teaching Applicants' final limitation of the independent claims, namely "installing the selected topographical components on one or more client computer systems." These sections and Figures of Chen are set forth below:

Chen, col. 12, lines 40-53:

FIG. 6B illustrates a business model dialog box 503 in a particular embodiment according to the present invention. Dialog box 503 is displayed whenever the "reverse star schema" component 504 is selected from project starting screen 501. Dialog box 503 enables the user to customize business templates based on prevailing business models in a particular industry. Dialog box 503 comprises a business model selection field 520 illustrating that the user is selecting a business model for the telecommunications industry. A plurality of

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business characteristics are prompted using check boxes 522, including whether the business is account, product or service based. Entering the appropriate information and clicking the "OK" button causes the embodiment to present a database creation screen.

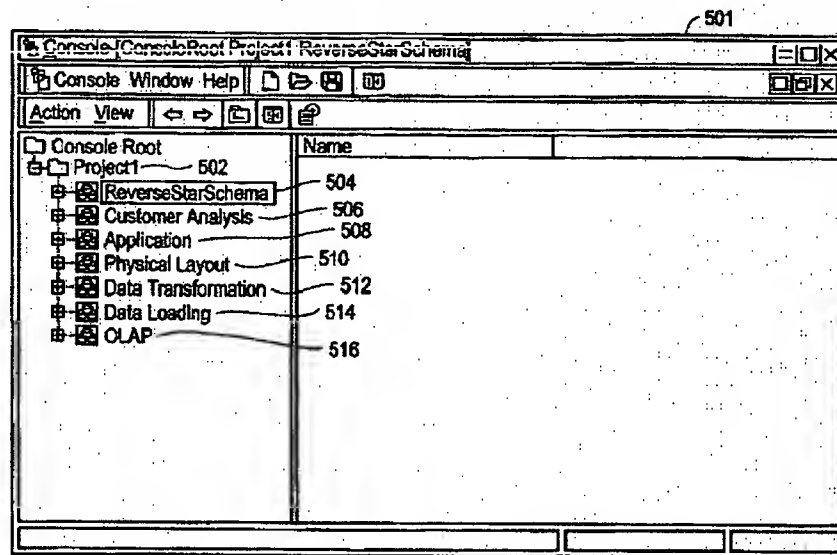


FIG. 6A

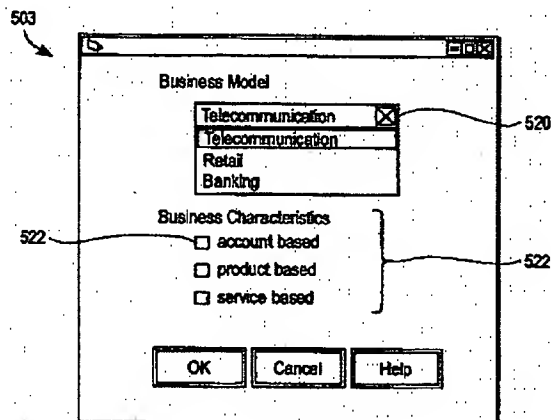


FIG. 6B

As previously discussed, nowhere does Chen teach or suggest selecting or creating software components, such as Applicants' claimed "topographical components." This failure of Chen is clearly evident in the above-cited sections and Figures. While Applicants claim "installing" software components on a client computer, nowhere in the cited sections and Figures, or elsewhere in Chen, does Chen teach or suggest "installing" any software components



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on any computer. In stating that the above-cited sections/figures teach Applicants' "installing..." limitation, the Office Action explains:

Chen specifically teaches business model dialog box displayed and selection of particular schema enables users to use business template[s] i.e., selection field illustrating that the user is selecting a particular business model for example selecting field element 520 related to telecommunications industry that corresponds to installing the selected topographical components on one or more client computer system (sic) as detailed in col. 12, line 12-43, fig. 6A-6B.

Applicants are baffled at how the Office Action derives Applicants' "installing..." limitation from Chen's system of a user using a business model dialog box and selecting a schema that appears in the dialog. Nowhere does Chen teach or suggest that anything is installed on a client computer system, let alone a software component such as Applicants' claimed topographical component. In the cited sections, Chen does not even teach installing a database (which Chen's system creates based upon customer attributes) onto a client computer system, yet somehow the Office Action uses Chen's business model dialog as teaching "installing ... selected topographical components on ... client computer systems." Applicants respectfully submit that this makes absolutely no sense whatsoever.

As set forth above, Chen clearly does not teach each and every limitation set forth in Applicants' independent claims. In fact, Applicants submit that Chen clearly fails to teach or suggest "selecting" any software components nor does Chen teach or suggest "installing" any software components onto a client computer system, two limitations set forth in each of the independent claims. Chen is a patent directed towards a system that helps a user create a database using predefined business models and has nothing to do whatsoever with using client attributes to install topographical software components on the client computer system. Applicants' comparison of Applicants' actual claim limitations with the teachings found in Chen readily reveals that Chen simply does not teach or suggest Applicants' claimed invention. Accordingly, each of Applicants' independent claims (claims 1, 8, and 14) are allowable over Chen. The remaining claims (claims 2-7, 9-13, and 15-20) are also each allowable for at least the same reasons that the independent claims are allowable.

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Claims 2, 9, and 15

Claims 2, 9, and 15 are dependent claims of claims 1, 8, and 14, respectively. Despite the fact that each of these claims are allowable because each depends on an allowable independent claim, the additional limitations claimed in these claims are additionally allowable because they are not taught or suggested by Chen. These claims are directed to a method / system / program product that further provides for "grouping a plurality of calibration factors into one or more calibration sets, wherein the comparing further includes comparing the identified client attributes to the calibration factor sets." The current Office Action cites Fig. 6E and col. 13, lines 1-11 of Chen, in support of this contention and cites col. 11, lines 39-44 as teaching Applicants' "wherein" clause found in claims 2, 9, and 15.

Chen, col. 13, lines 1-11:

Customization screen 509 illustrates a focal group 550 displayed to a user. The user can highlight a specific group, such as focal group 550, prompting the embodiment to present detail information about the group for editing and the like. A selection box 551 enables the user to select whether a new group is to be added or an existing group is to be edited or deleted. Focal group 550 includes a plurality of tables 552-559. The user can add new tables or edit existing tables within the group, plan for layout, identify data sources and specify data transformation for each table or column, or plan for data loading for a table.

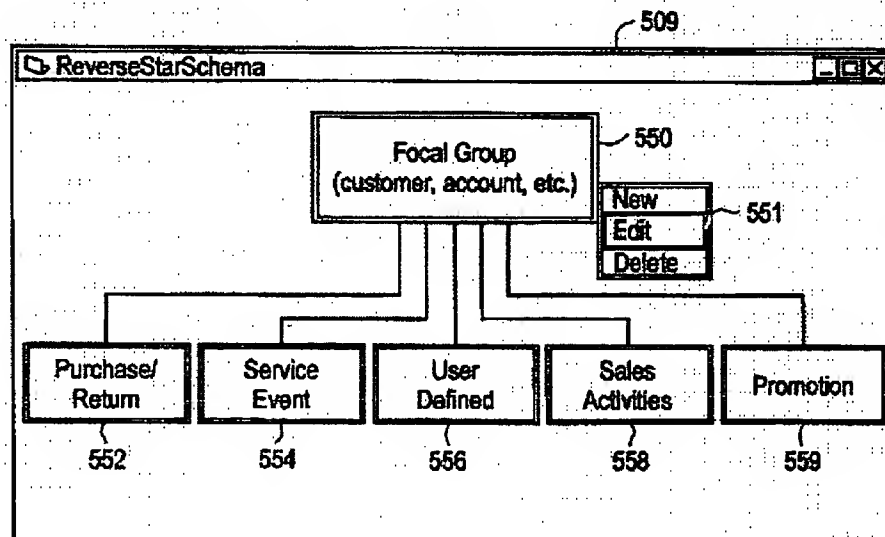


FIG. 6E

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Chen, col. 11, lines 39-44:

In a step 412, a plurality of source data tables and attributes are selected to match selected entities, such as the entities selected in 407. In some embodiments, users can browse and navigate through a data model of a data source, such as source data 101, to select data tables and attributes to comprise the source of the data tables and attributes of the customer-centric data warehouse.

Applicants note that the sections cited in the Office Action relate to various types of "focal groups" to assist the user in determining whether database changes, such as the addition of a new table is needed. Importantly, however, the "groups" described by Chen are not calibration factors. In addition, the "comparing" done by Chen at col. 11, lines 39-44 is not comparing the "groups" described by Chen at col. 13, lines 1-11 or Fig. 6E. Instead, in col. 11, lines 39-44, Chen is matching database tables and attributes to selected entities to filter out unnecessary entries (see element 407 on Fig. 5B). Consequently, Chen does not teach the grouping of calibration factors nor does Chen teach or suggest using calibration factors to compare client attributes to software components, as claimed by Applicants. Accordingly, claims 2, 9, and 15 are each allowable for these reasons as well as because each of these claims depend upon an allowable base claim.

**Claims 4, 11, and 17**

Claims 4, 11, and 17 are dependent claims of claims 1, 8, and 14, respectively. Despite the fact that each of these claims are allowable because each depends on an allowable independent claim, the additional limitations claimed in these claims are additionally allowable because they are not taught or suggested by Chen. These claims are directed to a method / system / program product that further provides for:

- storing one or more calibration factors corresponding to each of the topographical components in a component metadata file, wherein the comparing further includes comparing the identified client attributes with the calibration factors stored in the metadata file;
- identifying one or more components based on the comparing; and
- retrieving the identified components from a topographical component library.

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The current Office Action contends that each of these limitations is taught by Chen, citing col. 7, lines 59-62 and Fig. 3B as teaching the “storing” limitation, col. 8, lines 1-3 as teaching the additional “comparing” limitation, col. 8, lines 8-12 as teaching the “identifying” limitation, and col. 8, lines 13-20 as teaching the “retrieving” limitation.

Chen, col. 7, lines 59-62 (“storing” limitation):

FIG. 3B illustrates a representative meta model for a reverse star schema in a particular embodiment for performing customer data analysis according to the present invention.

Chen, col. 8, lines 1-3 (additional “comparing” limitation):

In a particular embodiment, customer data analysis involves correlating different activities within different customer activity components, such as customer activity components 215 of FIG. 3B.

Chen, col. 8, lines 8-12 (“identifying” limitation):

In some embodiments, data analyses operate on a more detailed level of customer activities. These embodiments search one or more activity lookup components, such as activity lookup components 214, for more detailed customer activity data.

Chen, col. 8, lines 13-20 (“retrieving” limitation):

The data in customer classification components provides different ways to categorize customers or different business views of the customers. For example, customers can be categorized by geographic region, demographics and the like. Embodiments using one or more of these types of customer classification components can provide a plurality of useful possible ways of viewing customer data analysis results.

Chen does not teach Applicants’ “storing” limitation. The section cited in the Office Action has nothing to do with storing and does not teach or suggest “storing” anything. Moreover, as described in detail above, Chen does not teach or suggest creating or selecting any software components analogous to Applicants’ topographical components. Chen also does not teach or suggest Applicants’ “identifying” limitation. Applicants’ limitation identifies software components while the cited section search for activity lookup components related to a customer’s database schema. Finally, Chen does not teach or suggest “retrieving” components from a component library. Instead, Chen teaches categorizing customers as possible ways of viewing customer data analysis results. Nowhere does Chen teach or suggest retrieving anything from a “library,” let alone retrieving identifiers for software components. As discussed above, Chen does not teach or suggest anything to do with selecting or creating software components, so it logically follows that Chen would not teach or suggest retrieving identifiers to software components from a component library. Accordingly, claims 4, 11, and 17 are allowable for the

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reasons set forth above in addition to their allowability because they depend from an allowable base claim.

Claims 5, 12, and 18

Claims 5, 12, and 18 are dependent claims of claims 1, 8, and 14, respectively. Despite the fact that each of these claims are allowable because each depends on an allowable independent claim, the additional limitations claimed in these claims are additionally allowable because they are not taught or suggested by Chen. These claims are directed to a method / system / program product that further provides for:

- packaging the selected topographical components in a topography installation file; and
- transmitting the topography installation file to the client computer system.

The current Office Action contends that Chen teaches Applicants' "packaging" limitation, citing col. 12, lines 54-62 in support of the rejection. This section reads as follows:

Chen, col. 12, lines 54-62:

FIG. 6C illustrates the contents of a general tab of database creation screen 505. Screen 505 includes a database name field 530, a database files area 532 and a file properties area 534. The user enters information appropriate for these fields and clicks the "OK" button. The user can select a transaction tab to display screen 507 in FIG. 6D. Screen 507 includes fields to enter information about the kind and size of a database transaction log, including a files area 542 and a file properties area 544.

As previously discussed, Chen does not teach or suggest creating or selecting software components. It follows that Chen cannot possibly teach packaging selected software components in an installation file and transmitting the file to a client. In the section cited in the Office Action, Chen describes a "database creation screen." Nowhere does Chen teach or suggest "packaging" anything or "transmitting" anything to a client computer screen. Instead, Chen describes entering data on a database creation screen. The cited section does not even teach or suggest what happens to the database once the data is entered. As Applicants' invention is directed to software components (topographical components) instead of databases, it follows that Chen does not teach or suggest any of the limitations set forth in claims 5, 12, and 18. Consequently, claims 5, 12, and 18 are independently allowable for these reasons in addition to

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these claims being allowable because they depend on allowable claims 1, 8, and 14, as described above.

**B. Alleged Obviousness Under 35 U.S.C. § 103 – Chen in view of Ankireddipally**

The current Office Action rejects claims 7, 13, and 20 under 35 U.S.C. § 103 as being obvious, and therefore unpatentable, over Chen in view of U.S. Patent No. 6,772,216 to Ankireddipally et al. (hereinafter “Ankireddipally”). Applicants are confused. Claim 13 does not include the same limitations as those set forth in claims 7 and 20. Additionally, claim 13 was rejected under 35 U.S.C. § 102(e) set forth in Paragraph 14 of the Office Action.

As an initial matter, claims 7 and 20 are dependent on independent claims 1 and 14, respectively, and are therefore allowable for at least the same reasons that claims 1 and 14 are allowable, as discussed in the preceding section. Claims 7 and 20 are directed to a method / program product that add the following limitation to their respective independent claims: “*installing one or more topography neutral application components on the client computer systems, wherein the topography neutral application components is adapted to interoperate with more than one topography.*” The Office Action admits that Chen does not teach “topography neutral application components.” In the preceding section of this Response, Applicants established that indeed Chen never teaches or suggests anything to do with “topography components” whatsoever. The current Office Action contends that Ankireddipally teaches “topography neutral application components” that are “adapted to interoperate with more than one topography,” citing col. 11, lines 24-29 and col. 14, lines 43-50 in support of this contention. These sections of Ankireddipally are set forth below:

Ankireddipally, col. 11, lines 24-29:

FIG. 1 illustrates a representative system architecture for enabling application-to-application interaction in a distributed computer network. Specifically, the system architecture of FIG. 1 illustrates an inter- or intra-enterprise Internet-based electronic commerce architecture including process automation application 10, referred to as a commerce exchange (CX) server.

Ankireddipally, col. 14, lines 43-50:

FIG. 2 illustrates a representative configuration of the application architecture required to implement the application interaction protocol in a distributed computer network such as the Internet. This application architecture makes use of the Document Object Model

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(DOM), a platform- and language-neutral application programming interface (API) for HTML and XML documents that models these documents using objects.

While Ankireddipally provides for a distributed system where applications interact with one another in an Internet-based electronic commerce architecture, it does not teach that "topographically neutral application components" are installed on client computer systems, nor does Ankireddipally teach or suggest that the components used in Ankireddipally's system can interoperate with more than one topography.

For an invention to be *prima facie* obvious, the prior art must teach or suggest all claim limitations. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). "All words in a claim must be considered in judging the patentability of that claim against the prior art." *In re Wilson*, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970). With regard to claims 7 and 20, the references fail to teach or suggest all elements of these claims. The independent claims on which these claims depend (1 and 14) include limitations not taught or suggested by Chen (as discussed above).

Moreover, the Office Action has failed to establish a *prima facie* case of obviousness because there is no motivation to combine the references, as required by the MPEP.

MPEP § 706.02(j) states, *inter alia*:

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on applicant's disclosure. *In re Vaack*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). See MPEP § 2143 - § 2143.03 for decisions pertinent to each of these criteria.

MPEP § 2143.01 states, *inter alia* (emphasis added):

"There are three possible sources for a motivation to combine references: the nature of the problem to be solved, the teachings of the prior art, and the knowledge of persons of ordinary skill in the art." *In re Rouffet*, 149 F.3d 1350, 1357, 47 USPQ2d 1453, 1457-58 (Fed. Cir. 1998) (The combination of the references taught every element of the claimed invention, however without a motivation to combine, a rejection based on a *prima facie* case of obvious was held improper.). The level of skill in the art cannot be relied upon to

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provide the suggestion to combine references. *Al-Site Corp. v. VSI Int'l Inc.*, 174 F.3d 1308, 50 USPQ2d 1161 (Fed. Cir. 1999).

"In determining the propriety of the Patent Office case for obviousness in the first instance, it is necessary to ascertain whether or not the reference teachings would appear to be sufficient for one of ordinary skill in the relevant art having the reference before him to make the proposed substitution, combination, or other modification." *In re Linter*, 458 F.2d 1013, 1016, 173 USPQ 560, 562 (CCPA 1972).

Obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either explicitly or implicitly in the references themselves or in the knowledge generally available to one of ordinary skill in the art. "The test for an implicit showing is what the combined teachings, knowledge of one of ordinary skill in the art, and the nature of the problem to be solved as a whole would have suggested to those of ordinary skill in the art." *In re Kotzab*, 217 F.3d 1365, 1370, 55 USPQ2d 1313, 1317 (Fed. Cir. 2000). See also *In re Lee*, 277 F.3d 1338, 1342-44, 61 USPQ2d 1430, 1433-34 (Fed. Cir. 2002) (discussing the importance of relying on objective evidence and making specific factual findings with respect to the motivation to combine references); *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988); *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992).

...

**THE FACT THAT REFERENCES CAN BE COMBINED OR MODIFIED IS NOT SUFFICIENT TO ESTABLISH PRIMA FACIE OBVIOUSNESS**

The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990) (Claims were directed to an apparatus for producing an aerated cementitious composition by drawing air into the cementitious composition by driving the output pump at a capacity greater than the feed rate. The prior art reference taught that the feed means can be run at a variable speed, however the court found that this does not require that the output pump be run at the claimed speed so that air is drawn into the mixing chamber and is entrained in the ingredients during operation. Although a prior art device "may be capable of being modified to run the way the apparatus is claimed, there must be a suggestion or motivation in the reference to do so." 916 F.2d at 682, 16 USPQ2d at 1432.). See also *In re Fritch*, 972 F.2d 1260, 23 USPQ2d 1780 (Fed. Cir. 1992) (flexible landscape edging device which is conformable to a ground surface of varying slope not suggested by combination of prior art references).

Applicants submit that there is no motivation to combine the references. Chen teaches a system to create databases for customer's given customer parameters. Ankireddipally, on the other hand, provides an Internet-based electronic commerce architecture. There is simply no motivation to combine Chen's database analysis system with Ankireddipally's commerce system. Indeed, neither reference teaches or suggests combining such teachings and the



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Examiner fails to provide any basis whatsoever for such a combination. Instead, the Examiner seems to state that combination of the references is proper "because both Chen and Ankireddipally are directed to business applications..." (Office Action, p. 8-9). It appears that the Examiner used Applicants' claim limitations as guideposts in searching and selecting references irregardless of whether such combination is proper. Accordingly, Applicants respectfully submit that the current Office Action employed "impermissible hindsight" after reviewing Applicants' claim limitations in selecting the references and rejecting Applicants' claims 7 and 20.


Claims 7 and 20 each depend on an allowable independent claim and, therefore, are allowable for at least the same reasons that the independent claims are allowable, as discussed above. In addition, Applicants have demonstrated that the rejection of these claims under § 103 was improper because (a) Ankireddipally does not teach the limitation set forth in claims 7 and 20, (b) there is no motivation to combine the references, and (c) the Examiner used impermissible hindsight in rejecting Applicants' claims. Accordingly, claims 7 and 20 are each allowable over Chen in view of Ankireddipally.

**Conclusion**

As a result of the foregoing, it is asserted by Applicants that claims 1-20 in the Application are in condition for allowance, and Applicants respectfully request an early allowance of such claims.

Applicants respectfully request that the Examiner contact the Applicants' attorney listed below if the Examiner believes that such a discussion would be helpful in resolving any remaining questions or issues related to this Application.

Respectfully submitted,

By   
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